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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,682	12/30/2003	Roy Ben-Yoseph	06975-541001/ Security 30	3174
26171 7590 08/19/2008 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER TAHA, SHAQ	
			ART UNIT 2146	PAPER NUMBER
			MAIL DATE 08/19/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/747,682	<b>Applicant(s)</b> BEN-YOSEPH, ROY	
	<b>Examiner</b> SHAQ TAHA	<b>Art Unit</b> 2146	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01/11/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### **Response to Arguments**

Applicant's arguments with respect to claims 1 - 49 have been considered but are moot in view of the new ground(s) of rejection.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1 – 8, 23 – 30, and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Friskel et al. (US 6,839,737).

- Regarding claim 1 & 23 & 45, Friskel teaches a method of providing online presence information: accessing a list of people inferred as known to a user, **[Fig. 1, Ref # 110 and 112 wherein a client contact list is shown]**; accessing online presence information for the user, **[Fig. 4, Ref # 114]**; determining a potential receiver of the online presence information, **[Fig. 4 shows the client as a potential receiver of the online presence of the contacts]**;

comparing the potential receiver to the accessed list to determine if the potential receiver is included on the list, **[Fig. 4, wherein the approved contact alias is the list];**

and determining whether to communicate the online presence information to the potential receiver based on whether the potential receiver is included in the list, **[Fig. 5 shows the approved contacts list and to communicate the online presence to the contact list].**

- Regarding claim 2 & 24, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining to not communicate the online presence information to the potential receiver when the potential receiver is not included in the list, **[Fig. 4, is receiver is not on list, online presence won't be communicated].**
- Regarding claims 3 & 25, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to communicate the online presence information to an instant messaging application of the potential receiver, **[Fig. 1, Ref # 108, wherein an E-mail server is equivalent to instant messaging].**
- Regarding claims 4 & 26, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver

comprises determining whether to display the online presence information on a web page, **[Fig. 3 shows an inbox which is a part of a webpage]**.

- Regarding claims 5 & 27, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to display the online presence information in member search results, **[Fig. 3, Ref # 304, wherein the search result is in the inbox]**.
- Regarding claims 6 & 28, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to display the online presence information in a member profile, **[Fig. 4, Ref # 114]**.
- Regarding claims 7 & 29, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to communicate the online presence information to the potential receiver when a request for online presence information is received from the potential receiver, **[Fig. 1, arrows 118 correspond to communication between client computer 104 and server 102 for requesting and providing member information for hidden contacts file 112]**.

- Regarding claims 8 & 30, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to communicate the online presence information to the potential receiver absent a request from the potential receiver for the online presence information, **[Fig. 4, Ref #114 wherein online status is available without request]**.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims and 9 – 22, 31 – 44, and 46 - 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel et al. (US 6,839,737), in view of Dieterman et al. (US 6,393,464).

- Regarding claim 9, 15, 16, 20, 21, 31, 37, 38, 42, 43, 46 and 48, Friskel et al. teaches a messaging system for indicating status of a sender of electronic mail and method and computer program product therefor.

Friskel et al differs from the claimed invention in that determining that a person is known to the user based on positive action is not taught by Friskel et al.

Dieterman teaches that the method further comprising: inferring that a person is known to the user based on positive user actions related to e-mail

communications from the person, **[Each message sent by or sent to the user will be categorized as either authorized if the other party to the communication appears on the allowed list, or unauthorized if the other party does not appear on the allowed list, (Column 2, lines 3 – 7)];**

adding the inferred person to the list, **[The administrator may view the content of the allowed list and add, delete and edit the identities of entities appearing on the allowed list, (Column 3, lines 54 – 57)].**

Dieterman further discloses the method wherein the communication is an instant messaging communication, **[Fig. 1, Ref # 111].**

Dieterman further discloses the method wherein the user actions comprise the user taking steps to add a person to a blacklist, **[Fig. 2, Ref # 15, 16, 17].**

Dieterman further discloses the method wherein the user actions comprise the user taking steps to move a communication from the person to either of a spam folder or a delete folder, **[Fig. 4, Ref # 77].**

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Friskel et al. by including inferring that a person is known to the user based on positive user actions related to e-mail communications from the person as taught by Dieterman.

One of ordinary skill in the art would have been motivated to make these modifications in order to provide the advantage of adding the inferred person to the list.

- Regarding claim 10 & 32, Friskel teaches the method wherein the positive actions include sending an E-mail to the person, **[Figure 1, Ref # 108]**.
- Regarding claims 11 & 33, Friskel et al. discloses the method wherein the positive actions include replying to, forwarding, saving, or printing e-mail received from the person, **[Fig. 3, Ref # 312]**.
- Regarding claim 12 & 34, Friskel teaches the method wherein the positive actions include moving an e-mail from a first folder to a second folder, **[Fig. 3, Ref # 312, 314]**.
- Regarding claim 13 & 35, Friskel teaches the method wherein the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder, **[Fig. 3, Ref # 312, 314]**.



- Regarding claim 14 & 36, Friskel teaches the method wherein the positive action includes leaving an e-mail from the person open for a predetermined period of time, **[Fig. 7, Ref # 706]**.
- Regarding claim 18 & 40, Friskel teaches that the method further comprising inferring that a person is known to the user based, at least in part, on detecting user actions that mitigate against factors that otherwise are used to infer a person is known to the user, **[Fig 6, Ref # 116]**.
- Regarding claim 19 & 41, Friskel teaches the method wherein the user actions comprise the user taking steps to report a communication from the person as spam, **[Fig. 5, Ref # 110]**.
- Regarding claims 17, 22, 39, 44, 47, and 49, Friskel teaches that the method further comprising: determining that a person is known to the user by accessing a contact list of the user, **[Fig. 6, Ref # 116]**; and adding the determined person to the list, **[Fig. 4, Ref # 114]**.

### **Conclusion**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaq Taha whose telephone number is 571-270-1921.

The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Put can be reached on 571-272-6798.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

06/02/08

S. Taha

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2146